

REMARKS

I. General

Claims 1-7, 9, and 11-19 are pending, and all are rejected by the Office Action mailed August 10, 2005. Claims 1, 9, 12, and 16 are amended, and claims 8 and 10 are canceled by this response. The issues in the current Office Action are as follows:

- Claims 1, 2, 4-7, and 9-20 are rejected under 35 U.S.C. §102(b) as being anticipated by US 5,987,609 (hereinafter, *Hasebe*).
- Claim 3 is rejected under 35 U.S.C. §103(a) as being obvious over *Hasebe* in view of US Pub. 2001/0045884 (hereinafter, *Barrus*).
- Claim 8 is rejected under 35 U.S.C. §103(a) as being obvious over *Hasebe* in view of US Pub. 2002/0004905 (hereinafter, *Davis*).
- Claims 9-20 are rejected under the same logic as claims 3 and 8.

Applicant hereby traverses the rejections and requests reconsideration and withdrawal in light of the remarks contained herein.

II. Comments on Specification

In the Office Action, the Examiner requests Applicant's assistance in correcting any errors in the specification. Applicant has not become aware of any such errors. Accordingly, no amendments to the specification have been made.

III. Amendments to the Claims

Claim 1 is amended herein to include the limitations of claim 8. Accordingly, no new matter is added. Since amended claim 1 effectively rewrites claim 8 in independent form, the amendment does not narrow the scope of claim 8, as originally filed. In view of the amendment to claim 1, claim 8 is canceled without prejudice.

Claim 9 is amended herein to include the limitations of claim 10. Accordingly, no new matter is added. Since amended claim 9 effectively rewrites claim 10 in independent form, the amendment does not narrow the scope of claim 10, as originally filed. In view of

the amendment to claim 9, claim 10 is canceled without prejudice. Further, claim 9 has been amended to change “right” to “rightful” in line 5. Such amendment is merely cosmetic in its correction of a typographical error. This amendment does not add new matter, nor does it narrow the scope of the claim.

Claim 12 has been amended to delete the term, “rightful,” in line 2. Such amendment is merely a cosmetic change that corrects a typographical error and does not add new matter, nor does it narrow the scope of the claim.

Claim 16 has been amended to recite that the means for preventing execution is implemented by an operating system of said system. No new matter is added by this amendment. In view of this amendment, claim 20 is amended to recite “said operating system” rather than “an operating system”, as the operating system is now introduced in claim 16. This amendment is made solely for clarity in referring to a term that now has sufficient antecedent basis provided by the independent claim.

IV. Claim Rejections

A. Claims 1-8

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. §102(b) as being anticipated by *Hasebe*. Claim 3 is rejected under 35 U.S.C. §103(a) as being obvious over *Hasebe* in view of *Barrus*. Claim 8 is rejected under 35 U.S.C. §103(a) as being obvious over *Hasebe* in view of *Davis*.

As discussed above, claim 1 is amended to include the limitations of claim 8. Because the Office Action admits that *Hasebe* does not teach the limitations of claim 8, the 35 U.S.C. §102(b) rejection of claims 1-7 is obviated. Applicant hereby addresses the rejection of claim 8, as it now pertains to claim 1.

Claim 8, the limitations of which are incorporated into amended claim 1, is rejected under 35 U.S.C. §103(a) as obvious over *Hasebe* in view of *Davis*. To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without

conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criterion, as discussed further below.

Amended claim 1 recites, in part, “a basic input/output system (BIOS) that is operable to boot said processor-based device and is further operable to verify integrity of said security protocol process before completing boot operations.” The Office Action does not rely upon *Hasebe* to teach or suggest this feature, nor does *Hasebe* teach or suggest this feature. Further, *Davis* does not teach or suggest this feature, contrary to the Office Action’s assertion, because *Davis* does not teach or suggest a BIOS that is operable to verify integrity of a security protocol. Paragraph [0018] of *Davis*, cited by the Office Action does not teach or suggest a BIOS that verifies integrity of a security protocol, and, in fact, does not mention a BIOS at all. Moreover, *Davis* teaches a system that authenticates BIOS code, rather than a BIOS that verifies integrity of a security protocol. See Abstract. Accordingly, the combination of *Hasebe* and *Davis* does not teach or suggest at least the above-quoted feature of amended claim 1.

Dependent claims 2 and 4-7 each depend either directly or indirectly from independent claim 1 and, thus, inherit all of the limitations of independent claim 1. Thus, neither *Hasebe* nor *Hasebe* in view of *Davis* teach or suggest all claim limitations of claims 2 and 4-7. It is respectfully submitted that dependent claims 2 and 4-7 are allowable at least because of their dependence from claim 1 for the reasons discussed above.

Further, claim 3 is rejected under 35 U.S.C. §103(a) as obvious over *Hasebe* in view of *Barrus*. As shown above, *Hasebe* does not teach or suggest all limitations of amended independent claim 1. Claim 3 inherits all of the limitations of claim 1. The Office Action does not rely on *Barrus* to teach the above-identified missing feature of claim 1, nor does *Barrus* teach the missing feature. It is respectfully submitted that dependent claim 3 is allowable at least because of its dependence from claim 1. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-7.

B. Claims 9-15

Claims 9-15 are rejected under 35 U.S.C. §102(b) as being anticipated by *Hasebe*. Claim 10 is canceled without prejudice, as discussed above.

Amended claim 9 recites, in part, “writing information in non-volatile memory of said processor-based device that said processor-based device is not in possession of said rightful user in response to said received message.” *Hasebe* does not teach at least this feature of claim 9. It appears that the Office Action cites *Hasebe* at column 6, lines 60-65, as teaching the feature. The cited passage teaches that the *Hasebe* security program, itself, is stored in its ROM (item 12 of Figure 3). However, the *Hasebe* security program is not “information...that said processor-based device is not in possession of said rightful user,” and the passage does not otherwise teach writing such information in non-volatile memory. Accordingly *Hasebe* does not teach the above-recited feature of amended claim 9.

Dependent claims 11-15 each depend from independent claim 9 and, thus, inherit all of the limitations of independent claim 9. Thus, *Hasebe* does not teach all claim limitations of claims 11-15. It is respectfully submitted that dependent claims 11-15 are allowable at least because of their dependence from claim 9 for the reasons discussed above. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 9 and 11-15.

C. Claims 16-20

Claims 16-20 are rejected under 35 U.S.C. §102(b) as being anticipated by *Hasebe*. Claim 20 is canceled without prejudice.

Amended claim 16 recites, in part, “wherein said means for preventing execution is implemented by an operating system of said system.” *Hasebe* does not teach at least this feature. The Office Action cites *Hasebe* at figure 3, item 12, column 5, lines 56-67, and column 6, lines 1-67, as teaching the feature. Office Action at 4. The Office Action further alleges that “the security protocol must be implemented within the operating system as it is part of the system and wouldn’t have functionality independently,” and that “the system software is contained together as separate modules reliant upon the operating system.” *Id.* The statements from the Office Action are incorrect, as discussed below.

First, figure 3 of *Hasebe* merely teaches that a security program is stored in Read Only Memory (ROM). *Hasebe* at Col. 6, lines 60-67. Storage in ROM is not enough, by itself, to teach “implemented by an operating system” because *Hasebe* does not mention or teach that the security program (or any other module in the cited ROM) is implemented by an operating system.

Second, the Office Action's statement that the security program of *Hasebe* must be implemented in an operating system is incorrect, as other configurations are possible—e.g., applications are commonly implemented to run on top of the operating system. Thus, not only does *Hasebe* not teach “implemented by an operating system,” but other configurations are possible. An application that provides security functionality and runs on an operating system and/or is reliant upon such operating system is different than implementing such functionality “by the operating system” itself. The Office Action appears to make some assumption that the software in *Hasebe* is reliant upon an operating system. However, no teaching (either express or inherent) is provided in *Hasebe* that its software is “implemented by” an operating system of the system that is being protected, as recited by claim 16.

Again, to anticipate a claim, a reference must teach each and every element of the claim. As discussed above, *Hasebe* fails to teach all elements of claim 16. Accordingly, the rejection of claim 16 should be withdrawn.

Dependent claims 17-19 each depend from independent claim 16 and, thus, inherit all of the limitations of independent claim 16. Thus, *Hasebe* does not teach all claim limitations of claims 17-19. It is respectfully submitted that dependent claims 17-19 are allowable at least because of their dependence from claim 16 for the reasons discussed above. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claims 16-19.

V. Note on Rejections

On page 6, the Office Action states:

Claims 9-15 and 16-20 are a method and system implementation of claims 3 and 8; therefore, claims 9-20 are rejected on the same grounds.

Applicant traverses the rejection for three reasons. First, the rejection is unclear as to how claims 9-20 are rejected. Applicant is unsure if all of claims 9-20 are rejected under the same logic as claim 3 and again under the same logic as claim 8 or if claims 9-15 are rejected under the same logic as claim 3 while claims 16-20 are rejected under the same logic as claim 8. In the latter scenario, the rejection is improper because “a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” M.P.E.P. §707.07(d). Applicant requests,

should the Examiner persist in this rejection, that it be written more clearly in subsequent non-final communication.

Second, claims 9-15 and claims 16-20 differ in scope from claims 3 and 8. It is respectfully submitted that each of claims 9-20 are unique in their scope, as defined by the language in those respective claims. Moreover, it should be noted that the first and second reasons (above) apply, as well, to the comments in the Office Action at page 4 under item 13.

Third, the cited art in the rejections of claims 3 and 8 does not teach or suggest all features of claims 9-20. For instance, independent claim 9 recites, in part, “writing information in non-volatile memory of said processor-based device that said processor-based device is not in possession of said rightful user in response to said received message.” As shown above, *Hasebe* does not teach this feature of claim 9. Also, neither *Davis* (as cited against claim 8) nor *Barrus* (as cited against claim 3) teaches or suggest the feature. Further, independent claim 16 recites, in part, “wherein said means for preventing execution is implemented by an operating system of said system.” As shown above, *Hasebe* does not teach this feature. Also, neither *Davis* (as cited against claim 8) nor *Barrus* (as cited against claim 3) teaches or suggest the feature. Accordingly, the art cited in the rejections of claims 3 and 8 does not teach or suggest all features of independent claims 9 and 16. The dependent claims are allowable at least because of their dependence from their respective base claims. For these reasons, Applicant respectfully requests the withdrawal of the rejections of claims 9-20.

VI. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10011529-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482711178US in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: November 10, 2005

Typed Name: Donna Forbit

Signature: Donna Forbit

Respectfully submitted,

By: 

Jerry L. Mahurin
Attorney/Agent for Applicant(s)
Reg. No. 34,661
Date: November 10, 2005
Telephone No. (214) 855-8386